

REMARKS/ARGUMENTS

Claims 1, 3-17, 19-25, 27-31 and 33-38 are pending in the present application. In an Advisory Action mailed July 9, 2004, the Examiner maintained the rejection of claims 1, 3-17, 19-25, 27-31, and 33-37, which was issued in the Office Action dated March 30, 2004. Claims 1, 17, 25, and 31 have been amended.

Reconsideration is respectfully requested in view of the above amendments and the following remarks.

A. Rejection of Claims 1, 3-17, 19-25, 27-31, and 33-37 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 3-17, 19-25, 27-31, and 33-37 under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,634,114 to Shipley (hereinafter, "Shipley") in view of U.S. Patent No. 6,377,977 to Sakata (hereinafter, "Sakata"). The Examiner rejected claims 4, 19 and 33 under 35 U.S.C. 103(a) as being unpatentable over Shipley in view of Sakata and further in view of Rupp et al., U.S. Patent Number 5,339,431 (hereinafter, "Rupp"). The Examiner rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Shipley in view of Sakata and further in view of Larsson et al., U.S. Patent Number 6,226,747 (hereinafter, "Larsson"). The Examiner rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Shipley in view of Sakata and further in view of Strellis et al., U.S. Patent Number 6,304,882 (hereinafter, "Strellis"). The Examiner rejected claims 25 and 28-30 under 35 U.S.C. 103(a) as being unpatentable over Shipley in view of Sakata and further in view of Yinger et al., U.S. Patent Number 5,960,204 (hereinafter, "Yinger"). The Examiner rejected claim 27 under 35 U.S.C. 103(a) as being unpatentable over Shipley in view of Sakata and further in view of Yinger and Rupp.

These rejections are respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142. A prima facie case of obviousness has not been established regarding claims 1, 3-17, 19-25, 27-31, and 33-38 because the prior art cited does not explicitly or implicitly teach or suggest all the claim limitations.

Claim 1 recites a “method for managing use of a software code by a selected application program.” Shipley does not disclose, nor does it teach or suggest the following required claim step: “detecting the use of the software code.” In the Advisory Action the Examiner stated that “[d]etecting the call to the DLL, i.e. detecting the use of the software code, is inherent to the operation of the version negotiation process.” See Advisory Action, page 2.

Though M.P.E.P. § 2112 states “inherent disclosures of a prior art reference may be relied upon in the rejection of claims,” the Federal Circuit requires that Examiners ““make clear that the missing descriptive matter is necessarily present in the thing described in the reference.”” Dayco Prods., Inc. v. Total Containment, Inc., 329 F.3d 1358, 1369 66 U.S.P.Q.2d (BNA) 1801 (Fed. Cir. 2003) (quoting Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 20 U.S.P.Q.2d (BNA) 1746 (Fed. Cir. 1991)). The M.P.E.P. further requires that the examiner ““provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”” M.P.E.P. § 2112 (quoting Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)).

The Federal Circuit has found inherency to be appropriate where the inherent limitation is “the ‘natural result’ flowing from the reference's explicitly explicated limitations.” Eli Lilly & Co. v. Barr Labs., 251 F.3d 955, 970 58 U.S.P.Q.2d (BNA) 1865 (Fed. Cir. 2001) (citing Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1269, 20 U.S.P.Q.2d (BNA) 1746, 1749 (Fed. Cir. 1991)). Additionally, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” Id. (citing In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993)). The Federal Circuit has held that “[a] claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.” Akamai Techs. v. Cable & Wireless Internet Servs., 344 F.3d 1186, 1192 68 U.S.P.Q.2d (BNA) 1186 (Fed. Cir. 2003) (citations omitted).

Applicants respectfully assert that Examiner has not met his burden of proof to establish an inherency argument. Specifically, the Examiner has not made clear that Shipley inherently detects the use of software code by providing a basis in fact or technical reasoning to reasonably support this assertion, Examiner merely asserts that it is so. Furthermore, the limitation is not inherent because, in Shipley, detecting the use of software code is simply not necessary. Shipley merely discloses an initial call to the DLL. Shipley states the following:

“Sometime after the application starts its execution (step 7), an initial call to the DLL is made (step 8). . . . [and then,] [i]n response to this initial DLL call, the DLL looks up preferred version number 9 in its version table (step 10).”

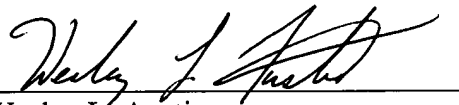
Shipley col. 6, lines 23-24 and 32-33. Shipley does not need to detect the use of software code because there is nothing to detect. Both the executable file and its corresponding DLL are known prior to the initial DLL call and their relationship is stored in their corresponding file headers, and as such, there is no need for any detection. See Shipley col. 6, lines 1-10. Furthermore, the executable file calls the DLL itself. See Id., at col. 6, lines 22-30 and Figure 2. Because the executable file calls the DLL and because the relationship between the executable file and DLL are known, there is no need to detect the use of the DLL. Because detecting the use of software code is not necessary in Shipley, it cannot be inherent to Shipley therefore the examiner has not established a prima facie case of obviousness.

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Upon further consideration, this information does not show any detecting of the use of software code, but rather discloses an initial call to the DLL. Shipley states that “[i]n the course of its execution, the application program calls subroutines within the DLL.” Shipley, Col. 4, lines 43-44. Making a call to a DLL is not “detecting the use of the software code.” Making a call to a DLL may be a form of “use of the software code”, but it is not “detecting the use.”

Additionally, claims 3-16, 19-24, 27-30, and 33-37 depend either directly or indirectly from claims 1, 17, 25, and 31 respectively. Thus, Applicants respectfully request that the rejection of claims 3-16, 19-24, 27-30, and 33-37 be withdrawn for at least the same reasons as those provided above with respect to claims 1, 17, 25, and 31. For the forgoing reasons, Applicants respectfully assert that claims 1, 3-17, 19-25, 27-31 and 33-38 are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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